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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of
CHEUNG et al.

Serial No. 09/975,507

Art Unit: 3644

Filed: October 12, 2001

Examiner: T. Dinh

For: CONFORMABLE SKIN ELEMENT SYSTEM FOR ACTIVE VORTEX CONTROL

RESPONSE

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To the Commissioner of Patents and Trademarks

Sir:

In response to the Office Action dated May 29, 2002, kindly consider the following:

The Examiner's contention in paragraph 2, page 2 is not understood. Applicant has depicted different elements of the invention in the figures whereas the Examiner states that those elements are different embodiments. For example, the different shapes that are shown in Figure 3 are not different embodiments. Clarification is kindly sought.

Regarding the species election requirement, Applicant provisionally elects Species A, with traverse. Claims 1-7, 15-36, and 40-47 read on the elected species.

Reconsideration and withdrawal of the election requirement are requested.

The claims of the numerous species do not relate to materially different devices, products or processes. They are

not related to materially different processes that would result in an apparatus used for different purposes nor can they be used to practice a different process than that intended and claimed.

The inventions as described in the claims are neither independent nor distinct. In fact, the inventions as claimed arise from the same inventive effort. Where inventions are neither independent nor distinct, restrictions should not be required. Where inventions arise from the same inventive effort, restriction should not be required.

MPEP § 802.01 points out that a sub-combination and a combination are not independent inventions, and that a process and an apparatus used in the practice of the process are not independent inventions. That same section points out that independent means that there is no disclosed relationship between the subjects disclosed.

The examiner has not made any requirement based on the subject matter being independent. Therefore it is understood that the examiner concedes that the subject matter is not independent.

The examiner's requirement for restriction is based upon his holding that the subjects are distinct. That is, as pointed out in MPEP § 802.01, the examiner has held that the subject matter as claimed:

are capable of separate manufacture, use or sale as claimed,
AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER.

The examiner has held under MPEP § 803 that the claimed inventions:

are able to support separate patents and they are ... distinct (MPEP § 806.05-806.05(i)).

However, MPEP § 803 unequivocally states:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

So that § 803 makes its point clearly, the serious burden requirement is repeated under the title:

CRITERIA FOR RESTRICTION BETWEEN
PATENTABLY DISTINCT INVENTIONS

MPEP § 803 goes on to state that there are two criteria for a restriction requirement: one, that the inventions must be distinct as claimed; and two, that there must be a serious burden on the examiner if restriction were not required.

Section 803 goes on to state under GUIDELINES an that examiner must provide reasons and/or examples to support conclusions. The examiner has never stated that there would be a serious burden on the examiner if restriction were not required. Indeed, there should be no serious burden on the examiner.

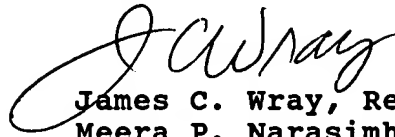
The Examiner has not shown any evidence of undue burden in searching all the species together. There should be no hardship on the examiner to complete examination for all species.

For the above reasons, the Applicant believes that the claims should be examined together. Hence, the Examiner should kindly withdraw the restriction and consider all the claims, 1-47.

Reconsideration and allowance of the application are requested. Reconsideration and withdrawal of the restriction

requirement are respectfully requested.

Respectfully,

A handwritten signature in cursive script, appearing to read "J C Wray", is written over the typed name.

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